

REMARKS

Claims 6-9, 11-15, and 19-36 are presently pending. An early indication of allowance is respectfully requested. This response follows the revised amendment format promulgated January 31, 2003 which waives the current requirement of 37 C.F.R. §1.121 for both a clean and marked up version of amendments.

Rejections Under 35 U.S.C. § 101

Claim 13 stands rejected as being direct to non-statutory subject matter because it “merely implies” being in the technological arts by not requiring any hardware in the method. Examiner has indicated that Applicant is required to specify the node type. Applicant respectfully disagrees.

When analyzing claims, the “claims must be read in view of the specification, of which they are a part.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995). The terms in a claim are given their ordinary meaning, unless it appears that the patentee used or defined the terms differently. *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988).

Claim 13 states “upon indication from a node associated with the e-commerce merchant that a transaction has initiated, providing an authorization form to a node associated with the customer, the authorization form being from a node associated with an entity separate from the e-commerce merchant.” The specification in the originally filed application reads:

Three nodes 14, 16, and 18 are illustrated as being attached to the network 12. The nodes 14-18 are illustrated as personal computers, but it is understood that each node can actually represent one or more different computing devices, including mainframes, servers, wireless telephones, personal digital assistants, and the like.

Referring to node 14 for example, the node includes a processing unit, a memory, and a network interface, generally represented as computer 14a. The computer 14a also includes a customer interface, which in the present example includes a monitor 14b and keyboard 14c. It is understood that each of the listed components may actually represent several different components. For example, the computer 14a may actually represent a distributed processing system including different levels of main memory, hard disks, server/client memory, and remote storage locations. (Original application, page 8, line 20 through page 9, line 7).

When reviewing claim 13, and reading its terms in view of the specification, it is clear that it is specifically within the technological arts and claims patentable subject matter. Accordingly, the Examiner’s rejection is improper and Applicant respectfully requests withdrawal of the rejection.

Independent Claim 13 Is Not Taught By Talati In View Of Biffar

Claims 6, 9, and 11-13 stand rejected as being obvious in light of U.S. Patent No. 5,903,878 (“Talati”) in view of U.S. Patent No. 6,205,435 (“Biffar”), and 7-8 stand rejected as being obvious in light of U.S. Patent No. 5,903,878 (“Talati”) in view of U.S. Patent No. 6,327,578 (“Linehan”) and U.S. Patent No. 5,909,492 (“Payne”). This rejection is respectfully traversed.

Even assuming that the combination of Talati and Biffar was permitted, the combination of these references fail to teach all of the limitations of claim 13. Independent claim 13 reads, in part, that the method comprises: “confirming rights in the account by associating an account code provided by the customer with an account number associated with the account.” To overcome the stated deficiency of Talati, the Examiner originally maintained that Biffar discloses “confirming rights in the account by associating an account code with an account number associated with the account. (see col. 10, lines 21-34).” (Office Action at page 4).

Biffar states:

When using the remote device 100 (FIG. 1-B) for the first time, the device must be initialized by receiving an identification number *from the central system* 200 (FIG. 1-B). The identification number is numerically linked to the central account number of the central account A 11. To do this, for example, user A uses the user controls 140 (FIG. 2) of the remote device to establish a connection between the remote device 100 (FIG. 1-B) and the central system 200 (FIG. 1-B). User A then inputs the user's central account number of central account A 11 and *the central system 200 (FIG. 1-B) creates an identification number for the remote device 100 (FIG. 1-B)* and sends the identification number to the remote device 100 (FIG. 1-B). The remote device 100 (FIG. 1-B) stores the identification number in its memory. (Biffar, col. 10, lines 21-34).

As is quite clear, the Patent Office did not take into account all of the recited elements of claim 13. To repeat, independent claim 13 reads, in part, that the method comprises: “confirming rights in the account by associating an account code *provided by the customer* with an account number associated with the account.” On the other hand, Biffar teaches an identification number that is created by the central system and which is provided to the customer's remote device.

Accordingly, as neither Talati nor Biffar disclose “confirming rights in the account by associating an account code provided by the customer with an account number associated with the account,” Applicant submits that claim 13 is in condition for allowance.

As dependent claims 6-9, 11-12, and 14-15 depend from and further limit independent claim 13, Applicant submits that claims 6-9, 11-12, and 14-15 are also in condition for allowance.

The Combination of Talati and Linehan Is Improper

Claims 19-36 stand rejected as being obvious in light of U.S. Patent No. 5,903,878 ("Talati") in view of U.S. Patent No. 6,327,578 ("Linehan"). This rejection is respectfully traversed.

As required under MPEP § 2142, "the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." In the present instance, the Examiner has not factually supported a prima facie case of obviousness as required in MPEP § 2142. As further stated in the MPEP:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

...
If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01.

The Examiner has attempted to combined Talati and Linehan to reject the pending claims because the Examiner believes that the patents can be combined. However, it is clear that Talati and Linehan are not properly combinable since, if combined, their intended function is destroyed and there is no desirability to combine the references. More particularly, Talati states:

This open exchange of digital signatures increases the potential of fraud. Thus, there is also a need for secure electronic commerce where the exchange of digital signatures between entities is eliminated. (col. 2, 10-14) (emphasis added).

On the other hand, Linehan states:

The invention includes the use of a variety of methods to perform authentication of the consumer with the issuer gateway 214. Examples include a userid and a password, an ATM debit card number and PIN, a smart card's account number and a symmetric Message Authentication Code (MAC), a smart card's account number and **an asymmetric digital signature, a consumer's digital signature and digital certificate, a consumer's a user account number and a symmetric MAC or asymmetric digital signature, a user account number and an asymmetric digital signature**, or a consumer's biometric signal. (col. 7, 39-49) (emphasis added).

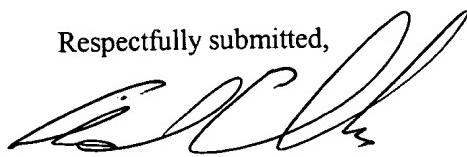
Talati clearly and specifically states that the open exchange of digital signatures increases the potential of fraud, thus creating a need to eliminate the need to exchange digital signatures. On the other hand, Linehan expressly requires digital signatures to function. One of ordinary skill in the art would not combine a reference that desires to eliminate digital signatures with a reference that requires digital signatures to function.

Therefore, for this reason alone, the Examiner has not established a prima facie case of obviousness, and the rejection of claims 19-36 under 35 U.S.C. § 103 should be withdrawn.

Conclusion

It is clear from all of the foregoing that claims 6-9, 11-15, and 19-36 are in condition for allowance. An early formal notice of allowance of claims is requested. The Examiner is invited to telephone the applicant's attorney at the number listed below if further assistance can be provided.

Respectfully submitted,



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